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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,700	02/07/2002	Andrew D. Firlik	337348020US4	2530

25096 7590 08/11/2005

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EXAMINER

BRADFORD, RODERICK D

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,700

Applicant(s)

FIRLIK ET AL.

Examiner

Roderick Bradford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 3,5-9,12,14-27,29-42 and 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10,11,13 and 28 is/are rejected.
- 7) ☒ Claim(s) 43-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 2, 4, 10, 11, 13 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by John et al. U.S. Patent No. 6,463,328.

Referring to claims 1 and 10 John discloses a method of effectuating an neural function in a patient comprising:

- Selecting a stimulation site at the cortex of the patient where a change in neural activity is suspected of occurring to carry out a particular physical function and/or cognitive function of the patient (column 6, lines 7-21)
- Positioning an electrode at the selected stimulation site (column 6, lines 7-21)

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- Applying an electrical potential to the stimulation site via the electrode
(column 6, lines 7-21)

Referring to claims 4 and 13 wherein, in a case in which the patient has experienced a stroke at the primary motor cortex in the frontal lobe, the procedure of selecting a stimulation site comprises choosing a stimulation site at the premotor cortex anterior to the stroke in the frontal lobe and the procedure of positioning an electrode comprises placing an electrode at the premotor cortex anterior to the stroke in the frontal lobe (column 6, lines 6-21 and column 27, lines 29-37).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over John et al. U.S. Patent No. 6,463,328 in view of Schiff et al. U.S. Patent No. 5,938,688.

Referring to claims 2 and 11, John discloses the claimed invention except for wherein the method further comprises:

- Providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions
- Selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the cortex of the patient in the second listing.

However Schiff discloses:

- Providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions (Table 2) as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.
- Selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the

cortex of the patient in the second listing (Table 3) as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of John to include providing a first listing containing a plurality of physical functions and/or cognitive functions and a second listing containing a plurality of neural-sites in the cortex where neural-activity is suspected to change to carry out a particular one of the physical functions and/or cognitive functions and selecting a stimulation site comprises identifying a physical function and/or cognitive function in the first listing that is correlated to an altered function of the patient, and determining a corresponding neural-site in the cortex of the patient in the second listing, such as taught by Schiff, as a means to easily identify specific sites of the cortical region that need to be stimulated to produce the desired outcome.

Allowable Subject Matter

7. Claims 43-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (571) 272-4942. The examiner can normally be reached on Monday - Friday 9 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. Bradford

R.B.

Angela D. Sykes

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